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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, CHAU T

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 02/19/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No.

09/524,849

Applicant(s)

TAYLOR, ESME M.

Examiner

Chau Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment A, received on 12/04/2004, has been entered. Claims 1-30 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. With respect to claim 2, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely

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exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "a single page with no sponsors", and the claim also recites "web page of a sponsor", which is the narrower statement of the range/limitation.

5. Claim 30 recites the limitation "the visible page" on page 7 of the amendment. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, US Patent No. 6,256,623 and further in view of Gupta et al. (Gupta), US Patent No. 6,487,538.

8. As to claim 1, Jones discloses a method comprising:

permitting a search (col. 7, line 59 – col. 8, line 17);

displaying a search result (col. 9, lines 1-11); and

Jones also discloses other frames in the search result containing advertising. However, Jones does not explicitly disclose incorporating a designated active and browseable web page of a sponsor on the same page as the search result. In the same field of endeavor, Gupta discloses advertisements appear in connection with frequently used web sites or advertising scheme bases the advertisement on input from the user, such as if a search for baby books were made on a search engine Yahoo, the web host for Yahoo may display advertisements relating to baby merchandise such as strollers and high chairs (Abstract, col. 4, lines 14-65). Also Gupta discloses advertising banner or icon may be an image, text, or an image with text that may have a hyperlink to the advertiser's web's page, thus, if a user clicks on an advertiser's banner, the user's browser will load the advertiser's web page (col. 4, lines 14-25). Since Gupta teaches a method for searching on the Internet, which is similar to network search access construct for accessing web-based search services of Jones, thus, it would have been obvious to one of ordinary skills in the art at the time the invention was made to combine the teachings of Jones and Gupta to include incorporating a designated active and browseable web based of a sponsor on the same page as the search result. Gupta suggests that by inserting advertisements into search result to gain publicity and web site access.

9. As to claim 2, Jones and Gupta disclose displaying a plurality of results on a single page, with no sponsors (Jones, col. 9, lines 1-11 and Fig. 5); and

when a user selects a single result, displaying the selected result with the incorporated designated web page of a sponsor (Gupta, (Abstract, col. 4, lines 14-65).

10. As to claim 27, Jones discloses a method comprising: a search (col. 7, line 59 – col. 8, line 17 and col. 9, lines 1-11). Jones also discloses other frames in the search result containing advertising. However, Jones does not explicitly disclose displaying data of a listee-sponsoree in response to a search; and displaying an active web page of a sponsor associated with the listee-sponsoree on the same page as the data of the listee-sponsoree, such that the active web page is accessible while reviewing the data of the listee-sponsoree. In the same field of endeavor, Gupta discloses advertisements appear in connection with frequently used web sites or advertising scheme bases the advertisement on input from the user, such as if a search for baby books were made on a search engine Yahoo, the web host for Yahoo may display advertisements relating to baby merchandise such as strollers and high chairs (Abstract, col. 4, lines 14-65). Also Gupta discloses advertising banner or icon may be an image, text, or an image with text that may have a hyperlink to the advertiser's web's page, thus, if a user clicks on an advertiser's banner, the user's browser will load the advertiser's web page (col. 4, lines 14-25). Since Gupta teaches a method for searching on the Internet, which is similar to network search access construct for accessing web-based search services of Jones,

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thus, it would have been obvious to one of ordinary skills in the art at the time the invention was made to combine the teachings of Jones and Gupta to include incorporating a designated active and browseable web based of a sponsor on the same page as the search result. Gupta suggests that by inserting advertisements into search result to gain publicity and web site access.

11. As to claim 30, Jones and Gupta disclose wherein the data of the listee-sponsoree is displayed in less than twenty percent of the visible page, while the active web page of the sponsoree is displayed in the remainder of the visible page (Gupta, col. 4, lines 19-25 and col. 15, lines 20-51).

12. Claims 3-11 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones and Gupta as applied to claims 1-2, 27, and 30 above, and further in view of Leal, US Patent No. 6,189,003.

13. As to claim 3, Jones and Gupta disclose limitations as discussed in claims 1-2. However, Jones and Gupta do not explicitly disclose wherein the plurality of results are displayed with an essential element missing. Applicant describes an essential element is a telephone number in the specification. In the same field of endeavor, Leal discloses a user enters a search provider's web site, a search result a list of items containing a "direct connection" link (an essential element) (Fig. 7, and col. 10, line 50 – col. 11, line 5). Thus, it is obvious to one of ordinary skills in the art at the time the invention was

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made to combine the teachings of Jones, Gupta, and Leal to include search results displayed with an essential element missing in order to provide users having possibility to make direct connection to web sites.

14. As to claim 4, Jones, Gupta, and Leal (Jones-Gupta-Leal) disclose wherein the essential element comprises a telephone number in a telephone directory (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

15. As to claim 5, Jones-Gupta-Leal disclose wherein the plurality of results are displayed with a “call now button” that automatically connects the user with the listee selected (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

16. As to claim 6, Jones-Gupta-Leal disclose wherein a telephone call using the call now button is free to the user (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

17. As to claim 7, Jones-Gupta-Leal disclose wherein the telephone called may be charged to one of the following: the listee selected, the sponsor of the listee selected, or another sponsor (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

18. As to claim 8, Jones-Gupta-Leal disclose playing an advertising to the user prior to connecting the user with the listee selected (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

19. As to claim 9, Jones-Gupta-Leal disclose playing an advertising to the listee prior to connecting the user with the listee (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

20. As to claim 10, Jones-Gupta-Leal disclose displaying a licensee's data if the user connected to the directory from a licensee (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

21. As to claim 11, Jones-Gupta-Leal disclose tracking the user for statistical and revenue sharing purposes (Gupta, col. 16, lines 35-61, and col. 17, lines 13-30).

22. As to claim 28, Jones-Gupta-Leal disclose wherein the data comprises Yellow Pages information (Leal, col. 6, line 64 – col. 7, line 10).

23. As to claim 29, Jones-Gupta-Leal disclose enabling the listee-sponsoree to self-sponsor the data of the listee-sponsoree, such that the listee-sponsoree's active web page is displayed with the data of the listee-sponsoree (Leal, Fig. 7, and col. 10, line 50 – col. 11, line 5).

Claim Rejections - 35 USC § 102

24. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

25. Claims 12-26 are rejected under 35 U.S.C. 102 (e) as being anticipated by Gupta et al. (Gupta), US Patent No. 6,487,538.

26. As to claim 12, Gupta discloses a method comprising:

permitting purchase a sponsorship of at least one listing based on a criteria (col. 4, lines 5-65); and

identifying a designated web page for incorporation on the same page as the listing when the sponsored listing is displayed as a search result, the designated web page being fully browseable to a user viewing the sponsored listing (col. 4, lines 5-65).

27. As to claim 13, Gupta discloses wherein the criteria comprises one or more of the following: a ZIP code, a city, a region, a telephone number, and SIC code, a

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demographic, a keyword, or an individual listing (col. 4, lines 53-65, col. 5, lines 17-35, and col. 10, lines 41-63).

28. As to claim 14, Gupta discloses wherein the demographic may be selected by a location of a user of the search (col. 4, lines 53-60).

29. As to claim 15, Gupta discloses wherein the demographic may be based on a SIC code (col. 4, lines 53-60).

30. As to claim 16, Gupta discloses wherein the demographic maybe based on a category of the listing (Abstract).

31. As to claim 17, Gupta discloses receiving a request for sponsorship of a group based on the criteria;

determining if the group is available for sponsorship (col. 12, lines 23-41); and
if the group is available for sponsorship, quoting a list price for the group (col. 12, lines 42-50).

32. As to claim 18, Gupta discloses if the sponsor agrees to pay the list price,
requesting the designated web page from the sponsor (col. 11, lines 126-65);
and

adding the sponsor and the designated web page into a database (col. 11, line 66 – col. 12, line 7).

33. As to claim 19, Gupta discloses linking the selected listee to the sponsor's web page (col. 12, lines 8-22);

designating a length of time the sponsor is linked to the listee (col. 4, lines 26-36, and col. 5, lines 54-63);

selecting a number of times the sponsor wants the sponsor's page to be shown (col. 12, line 51 – col. 13, line 42); and

setting a price for the sponsor (col. 12, line 51 – col. 13, line 42);

34. As to claim 20, Gupta discloses wherein setting the price comprises setting a price per impression or setting a price per time period (col. 4, lines 26-36, and col. 5, lines 54-63).

35. As to claim 21, Gupta discloses if the sponsor declines to pay the list price, prompting the sponsor to enter a bid for the sponsorship of the group (col. 13, lines 13-42) ; and

opening an auction for the sponsorship of the group (col. 14, lines 19-47).

36. As to claim 22, Gupta discloses notifying bidders of the sponsorship of an outcome of the auction (col. 14, lines 19-47); and

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requesting the designated web page for the group from the sponsor who won (col. 14, lines 19-47); and

adding the sponsor and the designated web page into a database (col. 11, line 66 – col. 12, line 7).

37. As to claim 23, Gupta discloses wherein the sponsorship comprises a price for each impression of the sponsor's designated web site with the at least one listing (col. 4, lines 26-36, and col. 5, lines 54-63).

38. As to claim 24, Gupta discloses wherein the sponsorship may be a self-sponsorship, such that a web page displayed is a web page of the listee (col. 12, lines 8-22).

39. Claims 25-26 are corresponding apparatus claims containing similar limitations as discussed in claims 12-24; therefore, they are rejected under the same rationale.

Response to Arguments

In the remarks, Applicant argued in substance that

(A) Prior art does not teach or including a fully browseable designated web page with a listing.

As to point (A), Gupta discloses advertisements appear in connection with frequently used web sites or advertising scheme bases the advertisement on input from the user, such as if a search for baby books were made on a search engine Yahoo, the web host for Yahoo may display advertisements relating to baby merchandise such as strollers and high chairs (Abstract, col. 4, lines 14-65). Also Gupta discloses advertising banner or icon may be an image, text, or an image with text that may have a hyperlink to the advertiser's web's page, thus, if a user clicks on an advertiser's banner, the user's browser will load the advertiser's web page (col. 4, lines 14-25).

(B) Prior art does not teach or suggest such a relationship between listee-sponsoree and a sponsor.

As to point (B), Gupta discloses advertiser (listee-sponsoree) informs proxy (sponsor) what advertiser is willing to pay for a specific advertisement displayed to a particular user with specified demographic information (col. 15, lines 57-7).

(C) Prior art does not teach or suggest an association between a listee-sponsoree and a sponsor, nor incorporating a fully navigable web page on the same page as a search result.

As to point (C), Gupta discloses advertiser (listee-sponsoree) informs proxy (sponsor) what advertiser is willing to pay for a specific advertisement displayed to a particular user with specified demographic information (col. 15, lines 57-7). Gupta also discloses advertisements appear in connection with frequently used web sites or advertising scheme bases the advertisement on input from the user, such as if a search for baby books were made on a search engine Yahoo, the web host for Yahoo may display advertisements relating to baby merchandise such as strollers and high chairs (Abstract, col. 4, lines 14-65). Also Gupta discloses advertising banner or icon may be an image, text, or an image with text that may have a hyperlink to the advertiser's web's page, thus, if a user clicks on an advertiser's banner, the user's browser will load the advertiser's web page (col. 4, lines 14-25).

(D) Prior art does not teach or suggest plurality of results are displayed with an essential element missing.

As to point (D), Jones and Gupta disclose limitations as discussed in claims 1-2. However, Jones and Gupta do not explicitly disclose wherein the plurality of results are

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displayed with an essential element missing. Applicant describes an essential element is a telephone number in the specification. In the same field of endeavor, Leal discloses a user enters a search provider's web site, a search result a list of items containing a "direct connection" link (an essential element) (Fig. 7, and col. 10, line 50 – col. 11, line 5). Thus, it is obvious to one of ordinary skills in the art at the time the invention was made to combine the teachings of Jones, Gupta, and Leal to include search results displayed with an essential element missing in order to provide users having possibility to make direct connection to web sites.

40. Applicant's arguments filed 12/04/2003 have been fully considered but they are not persuasive. Please see the Rejection and Reply to Arguments above.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (703) 305-4639. The examiner can normally be reached at 8:00 am – 5:00 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3230.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20131

Or Faxed to:

(703) 872-9306, (for **formal communications**; please mark
"EXPEDITE PROCEDURE").

Or:


(703) 746-7240 (for **informal or draft communications**, please label
"PROPOSED" or "DRAFT").

Or:

(703) 872-9306 (for **After Final Communications**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

Chau Nguyen
Patent Examiner
Art Unit 2176


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER